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By: Kristine C. Bruno Date: 10 August 2006

Docket No.: **242/9-2075**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Gerolamo FIORI

Conf. No.: 6016

Serial No.: 10/531,923

Filed: 19 April 2005

For: **DEVICE AND METHOD FOR CONTROLLING THE CONDENSATE AND/OR FROST FORMATION IN CHOCOLATE SHELL MOULDING**

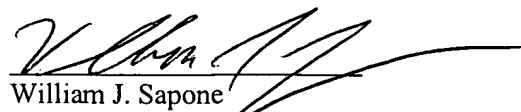
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**Re : Renewed Submission Under 37 CFR 1.42**

Sir:

In response to the Decision on Request Under 37 CFR 1.42 mailed 7 July 2006, enclosed herewith is a new Declaration executed by the sole heirs of the deceased inventor, Gerolamo Fiori. The Declaration identifies the inventor, Gerolamo Fiori, the two sole heirs, their citizenship and residence. The Declaration is now believed to be in compliance with 37 CFR 1.497 (a)-(b).

Respectfully submitted,



William J. Sapone  
Registration No. 32,518  
Attorney for Applicant(s)

COLEMAN SUDOL SAPONE, P.C.  
714 Colorado Avenue  
Bridgeport, Connecticut 06605-1601  
Telephone No. (203) 366-3560  
Facsimile No. (203) 335-6779

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WILLIAM J. SAPONE  
COLEMAN SUDOL SAPONE P.C.  
714 COLORADO AVENUE  
BRIDGEPORT, CT 06605

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COLEMAN SUDOL SAPONE, P.C.

In re Application of :  
FIORI, Gerolamo :  
Application No.: 10/531,923 :  
PCT No.: PCT/IB03/04607 :  
Int. Filing Date: 20 October 2003 :  
Priority Date: 21 October 2002 :  
Attorney's Docket No.: 242/9-2075 :  
For: DEVICE AND METHOD ... CHOCOLATE :  
SHELL MOULDING :

DECISION ON

REQUEST

UNDER 37 CFR 1.42

This decision is in response to applicant's renewed request under 37 CFR 1.42 filed in the United States Patent and Trademark Office on 05 December 2005.

**BACKGROUND**

On 03 October 2005, the Office mailed Decision On Request Under 37 CFR 1.42, refusing applicant's request for status under 37 CFR 1.42.

On 05 December 2005, applicant submitted a renewed request under 37 CFR 1.42. The submission included a certificate of mailing indicating that it was deposited on 02 December 2005.

**DISCUSSION**

Under 35 U.S.C. § 117, legal representatives of deceased inventors may make application for patent upon compliance with the requirements and on the same terms and conditions applicable to the inventor. The "legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent." 37 CFR 1.42.

The 19 April 2005 declaration did not satisfy 37 CFR 1.497(a)-(b). It failed to list the inventor and his citizenship as required and instead listed two people as "heirress" for the first and second inventor. Additionally, a name was stricken on each inventor's signature line. These appear to be undated, non-initialed alterations. 37 CFR 1.52(c)(1). As such, the declaration would have been unacceptable regardless of compliance with 37 CFR 1.497(a)-(b). Applicant was informed that the declaration must list the inventors and their citizenships and the legal representative and the legal representative's citizenship, residence and postal address. See 37 CFR 1.497. The declaration appeared to list the information for the heiresses, but not for the deceased inventor.

On 05 December 2005, applicant submitted a declaration listing the deceased inventor, a citizenship, the sole heirs and the residence and postal address of the sole heirs. A declaration signed by the "sole" heirs is construed as a statement that a legal representative has not been appointed, nor is one required to be appointed under applicable law and that the authority of the heirs corresponds to that of a legal representative. The declaration was signed by each of the heirs. This declaration fails to comply with 37 CFR 1.497(a)-(b).

The declaration must list: (1) the inventors, (2) the citizenship of each inventor, (3) the legal representatives, (4) the citizenship of each legal representative, (5) the residence and mailing address of each legal representative. The declaration lists a citizenship, but not three. The citizenship listed is not identified as belonging to the deceased inventor nor to either of the heirs.

CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is REFUSED.

Applicant is required to submit a declaration in compliance with 37 CFR 1.497(a)-(b) and 1.42 and the surcharge for late filing of the oath or declaration within a time period of **TWO (2) MONTHS** from the mail date of this Decision. **THIS PERIOD FOR RESPONSE MAY BE EXTENDED UNDER 37 CFR 1.136(a). FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.** Any request for reconsideration of this decision should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42."

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

*Erin P. Thomson*

Erin P. Thomson  
Attorney Advisor  
PCT Legal Administration

Telephone: 571-272-3292  
Facsimile: 571-273-0459